

Application No.: 10/619008

Case No.: 53867US018

Remarks

Claims 1 -19 are pending. Claims 8 and 13 have been cancelled. Claims 14 and 16 have been withdrawn from consideration. Claims 1 and 10 are amended.

Restriction Requirement

The Examiner issued a Restriction Requirement under 35 U.S.C. 121 in the above-identified application, grouping the claims as follows: Group I, Claims 1-13, 15 and 17-19 drawn to fluid composition; Group II, Claim 14 drawn to transdermal drug delivery system, Group III, Claim 16 drawn to a covering device. A provisional election to prosecute Group I, claims 1-13, 15 and 17-19 of the invention was made in response to a telephone conversation between Chereé H. Johnson (formerly Chereé M. Haswell) and the Examiner on April 14, 2004. The provisional election to prosecute Group I is herein affirmed.

Applicants reserve the right to pursue patent protection for the inventive subject matter of the withdrawn and canceled claims in one or more other applications.

Claim Rejections - 35 USC § 112

Claims 1-13, 15 and 17-19 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

As the Examiner correctly points out, Claims 1-13, 15 and 17-19 disclose using a fluid composition as a covering element onto a surface. The Examiner indicates that it is unclear by way of the claims what the "surface" is. In accordance with the Applicant's invention, the term "surface" in this invention is used in the ordinary sense of the term. For example, in US 6,627,216 B2 (a continuation of the present application and the disclosure of which is incorporated by reference) on column 6, line 23, Applicants point out "...for applications involving topical treatment of the skin or another exposed surface of a host, such as the oral tissue, the fluid composition may be coated directly over the treatment site. For topical applications in which the fluid composition will be used to form a protective bandage over a

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wound...". The term "surface" refers to any surface that the composition may be applied to, with examples, such as skin, oral tissue, and wounds, being specifically noted in the specification.

Claim 10 stands rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner indicates that it is unclear how water alone is a volatile solvent.

Claim 10 has been amended to remove reference to "water."

In summary, Applicant submits that the rejection of claims 1-13, 15 and 17-19 under 35 USC § 112, second paragraph, have been overcome, and that the rejection should be withdrawn.

Non-Statutory Double Patenting Rejection

Claims 1 and 6-8 stand rejected under the judicially created doctrine of obviousness-type double patenting as purportedly being unpatentable over claims 1 and 2 of U.S. Patent No. 6,627,216 B2.

In conjunction with this response, Applicants have filed a terminal disclaimer under 37 CFR § 1.321(c).

§ 103 Rejection

Claims 1-4, 6, 7, 9-13, 15, 17 and 18 stand rejected under 35 USC § 103(a) as being unpatentable over Salamone et al. (U.S. Patent 5,103,812). The rejection is respectfully traversed. The Office Action essentially states Salamone discloses a conformable bandage and coating material that is applied to the skin as a liquid and dries to form a solid protective film. The Office Action adds that the fluid composition comprises siloxane-containing polymers, together with additional polymerizable monomers incorporated into a solvent system. Further, the Examiner correctly indicates that the prior art does not teach the non-tacky component comprising at least one surface energy, surface seeking moiety. The Office Action indicates that it would have been obvious to one skilled in the art to incorporate a siloxane-containing polymer as the non-tacky component because Salamone teaches that the siloxane-containing polymer of a controlled weight provides non-tacky characteristics.

The Salamone polymer is analogous to glue, which is not tacky itself but will adhere to a surface because of a liquid carrier and then solidifies into a solid, non-tacky material after the

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volatile carrier solvent evaporates. Thus the coating material in Salamone lacks "an effective amount of a tacky component " in the coating material, which is required by Claim 1 of Applicant's invention.

Further, claim 1 of the Applicant's invention requires a separate "film-forming, non-tacky component, wherein said film-forming, non-tacky component comprises at least one low surface energy, surface seeking moiety ... incompatible with the tacky component ... present in an effective amount such that upon application it undergoes phase separation from the tacky component such that an outer surface of the in situ formed covering element is non-tacky when the covering element is touch dry ...". While Salamone discloses possible inclusion of siloxane-containing polymers, it does not disclose or suggest any formulation including such polymers where they could constitute a separate "film-forming," "low surface energy, surface seeking" component that is "incompatible with the tacky component" and in an effective amount" to a "form non-tacky covering element." To the contrary, Salamone appears to contemplate only a conventional, homogenous polymer formulation that simply dries in place.

Hence, Salamone does not disclose formulations with separate tacky and non-tacky components that are incompatible and undergo phase separation upon drying. The tacky component of the Applicant's invention dries below the non-tacky protective film, providing the bottom surface of the covering element with sufficient tack to adhere to the intended surface.

For these reasons, Applicants submit that Salamone will not support a 103(a) rejection of the claimed invention and request that the rejection be withdrawn.

Conclusion

In view of all of the above, it is submitted that the application is in condition for allowance. Reconsideration and favorable action are therefore requested. Please do not hesitate to contact the undersigned if there are any questions or suggestions for progressing the application.

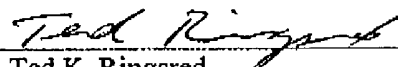
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Respectfully submitted,

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